

REMARKS

Claims 1-16 are pending in the application with claims 1, 6 and as independent.

Claims 1-16 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement.

Claims 1-4, 6-9 and 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 6,370,112 (Voelker) in view of US 5,809,011 (Almay).

Claims 5 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of Voelker in view of Almay and further in view of US 6,535,489B1 (Merchant).

Claims 1, 6 and 11 are rejected under 35 U.S.C. §102(e) as being anticipated by Boduch US006667954B1 (Boduch).

Claims 1-4, 6-9 and 11-16 are rejected under 35 U.S.C. §103(a) as being unpatentable over Almay in view of US 6,028,861 (Soirinsuo).

Claims 5 and 10 are rejected under 35 U.S.C. §103(a) as being unpatentable over Almay in view of Soirinsuo as applied to claims 1 and 6 above, and further in view of Merchant.

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel

and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

Rejection Under 35 U.S.C. §112

Claims 1-16 are rejected under 35 U.S.C. §112, ¶1, as failing to comply with the written description requirement. In an attempt to support the rejection, the examiner alleges: "In general, nowhere in the original disclosure discloses the newly added limitation discloses the newly added limitation as set forth above. In particular, neither FIG. 10 nor corresponding recitation discloses this newly added limitation either. First, by only disclosing 'discarding out of order packets' in the original specification is not sufficient to provide enabling support for '*allow less of a number of bits to be forwarded than were transmitted.*'" See Office Action, page 8. Applicants respectfully disagree. The Examiner's attention is directed to page 2 of the last response filed with the USPTO on December 2, 2008. Applicants therein indicated that support for the amendment is found on page 6, lines 16-18. This passage is reproduced here for ease of reference. "*Discarding a data packet implies not accepting the arrival of a data packet. It follows that data packet 4 is not discarded and is forwarded by switch S2 towards destination address B, finally leading to the arrival of data packets 1, 3 and 4 at destination address B as shown in figure 7.*" Applicants note that data packets 1, 2, 3, 4 were originally

transmitted, whereas, only data packets 1, 3, 4 arrive at the destination. (See FIG. 1 and pp. 5-6, line 25-line 19 of the specification). This passage clearly discloses the claimed feature.

When basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. §112, USPTO personnel must establish on the record a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation. See *In re Brown*, 477 F.2d 946, 177 USPQ 691 (CCPA 1973). MPEP 2162.01(III). The linchpin of 112 first paragraph is "undue experimentation." The Examiner was unable to articulate a reasonable basis, because no experimentation is required in order to make and use the present invention. The disclosure makes it clear that data packets 1, 2, 3, 4 were originally transmitted, however, only data packets 1, 3, 4 arrive at destination B. There is no experimentation required by the average individual because an artisan of ordinary skill in the art would be easily comprehend the above-referenced disclosure. Without a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation, the rejection must be withdrawn.

Furthermore, the Examiner added "Second, if less of a number of bits are forwarded than were transmitted, then the transmission of such partial bits would be erroneous and incomplete since the number of originally transmitted bits and the number forwarded of bits will no longer being the same." In the instant application, the network comprises at least two mutually different routing paths between the source and the switch, wherein the switch comprises two incoming ports for receiving data packets originating from the source. Although the Examiner claims it would be erroneous in reference to the instant application, however, the same Examiner, asserts that Boduch discloses the same limitation. See Office Action, page 3.

Double Patenting Rejections

Claims 1-4, 6-9 and 11-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of Voelker in view of Almay.

Claims 5 and 10 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 of Voelker in view of Almay and further in view of Merchant.

The Applicants thank the Examiner for deferring the double patenting rejection until all other grounds of rejection are overcome.

Rejection Under 35 U.S.C. §102(e)

Claims 1, 6 and 11 are rejected under 35 U.S.C. §102(e) as being anticipated by Boduch US006667954B1 (Boduch). The rejection is traversed.

According to MPEP §2131.03 (III) "Anticipation under §102 can be found only when the reference discloses exactly what is claimed and that where there are differences between the reference disclosure and the claim, the rejection must be based on §103 which takes differences into account. Furthermore, in order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." See MPEP §2131.03 (II).

The Boduch reference fails to disclose each and every element of the claimed invention, as recited in amended independent claim 1. Specifically, the Boduch reference fails to teach or suggest at least the claim element "said data packets are discarded or accepted depending on the source from which the data packet originates," as recited in amended independent claim 1.

The Boduch reference is directed toward "selecting the better of two or more copies of a cell in a cell-oriented redundant switching system connected to an external communications network" (see Boduch, Abstract). Claim 1 is amended to recite in part said data packets are discarded or accepted depending on the source from which the data packet originates, which is not taught by Boduch expressly or impliedly. This application discloses "discarding," wherein cells are irrevocably prevented from being forwarded, as exemplified among other places in the Applicants' Fig. 10, wherein cells 1, 3 and 4 are forwarded, and cell 2 is "discarded" with Destination B not receiving a "copy" of a cell; thereby allowing less of a number of bits to be forwarded than were transmitted, in contrast to less bits than were transmitted clearly being forwarded resultant from the claimed "discarding."

As such, independent claim 1 is not anticipated by Boduch and is patentable under 35 U.S.C. §102. Independent claims 6 and 11 recite relevant limitations similar to those recited in independent claim 1 and, as such, and at least for the same reasons as discussed above, these independent claims also are not anticipated by Boduch and are patentable under 35 U.S.C. §102.

In view of the above, Applicants respectfully request the rejection of claims 1, 6 and 11 be withdrawn.

Rejection Under 35 U.S.C. §103(a)

The Examiner bears the initial burden of establishing a prima facie case of obviousness. See MPEP § 2141. Establishing a prima facie case of obviousness begins with first resolving the factual inquiries of *Graham v. John Deere Co.* 383 U.S. 1 (1966). The factual inquiries are as follows:

- (A) determining the scope and content of the prior art;
- (B) ascertaining the differences between the claimed invention and the prior art;
- (C) resolving the level of ordinary skill in the art; and
- (D) considering any objective indicia of nonobviousness.

Once the *Graham* factual inquiries are resolved, the Examiner must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. The key to supporting a rejection under 35 U.S.C. §103 is the clear articulation of the reasons why the claimed invention would have been obvious. The analysis supporting such a rejection must be explicit. "[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006), cited with approval in *KSR Int'l Co. v. Teleflex, Inc.*, 126 S. Ct. 2965 (2006); see also MPEP §2141.

According to MPEP §2143.03: "All words in a claim must be considered in judging the patentability of that claim against the prior art" (*quoting, In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). In addition, to establish a prima facie case of obviousness the prior art reference (or references when combined) must

teach or suggest all elements of the subject claim. *In re Wada*, 2007-3733 (BPAI Jan. 14, 2008) (citing, *CMFT, Inc. v. Yieldup Intern. Corp.*, 349 F.3d 1333, 1342 (Fed.Cir. 2003)).

Claims 1-4, 6-9 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almay in view of Soirinsuo. The rejection is traversed.

According to MPEP §2143, to establish a *prima facie* case of obviousness under §103, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants respectfully maintain that the Office Action failed to establish a *prima facie* case of obviousness, because the combination of Almay and Soirinsuo fails to teach or suggest all the claim elements.

The invention is directed toward receiving packets simultaneously from at least two different paths, and discarding packets at their port of arrival if they are detected to be out of order. Specifically, the invention claims “in response to a commonly sourced data packet being received out of order at a first of the plurality of input ports, commonly sourced data packets received at the first input port are discarded for a period of time while commonly sourced data packets received at the other input port are processed said data packets are discarded or accepted depending on the source from which the data packet originates.” To the contrary, Soirinsuo never allows data at any more than one input port to be considered, or “processed,” at any given time. Soirinsuo instead teaches an *all-or-nothing* switching process, wherein *all* data transmissions are permitted to be forwarded (with no data being “discarded”) from a particular port, while *no* data is permitted to be forwarded from the other(s). Soirinsuo succinctly explains this with “for an egress switch-over, the ATM switch will send out all cells coming from the ‘new’ connection, and discard all cells received on the ‘old’ channel” (col. 10, lines 25-27,

emphasis added). The Soirinsuo switchover is completely discrete, where after no cells arriving at any input port that has not been explicitly switched to are even considered, be they out-of-order or not.

Even though Soirinsuo mentions the word “discard,” the Applicants respectfully maintain that the art distinctly teaches away from “discard,” as specifically claimed. Soirinsuo does not mention any provisions for actually *detecting* if packets or cells are being received out of order or not, so for one, it is not even possible for Soirinsuo to specifically respond “to a commonly sourced data packet being received out of order” by any means. Soirinsuo merely entails waiting until a “frame completed” state is received before performing a switchover (Figure 10), and then performing the switchover *immediately* after that occurs. Soirinsuo Figure 9, and column 9, lines 51-54 explains “the integrity of AAL-5 packets 901 can be maintained by timing the switch-over so that switchover 902 happens right after a cell 904 having a last cell indication set, e.g., the AUU or user signaling bit.” As is shown, all processes in Soirinsuo are clearly directed toward *completely* receiving all cells on a singular elected path, and not *discarding* any of them once cell reception has begun. To do so would be contrary to the entire premise of Soirinsuo. Thus, in addition to not teaching “discard” as represented by the claims, the Applicants respectfully submit that Soirinsuo in fact teaches away from the claim element in the manner it is presented in the claims as well.

Therefore, Almay in view of Soirinsuo does not satisfy the requirements for a 35 U.S.C. 103(a) rejection according to MPEP §2143. The arguments of the Office Action against independent claims 6 and 11 are the same as those against independent claim 1, so the same response in defense of claim 1 from above also applies to claims 6 and 11, and need not be repeated.

Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Almay in view of Soirinsuo under 35 U.S.C. §103(a).

In view of the above, Applicants respectfully request the rejection of claims 1-4, 6-9 and 11-16 be withdrawn.

Claims 5 and 10

Claims 5 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Almay in view of Soirinsuo as applied to claims 1 and 6 above, and further in view of Merchant. The rejection is traversed.

Each ground of rejection applies only to dependent claims, and each is predicated on the validity of the rejection under 35 U.S.C. 103 given Almay in view of Soirinsuo as applied to claims 1 and 6 above, and further in view of Merchant. Since the rejection under 35 U.S.C. 103 given Almay in view of Soirinsuo has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that Merchant supplies that which is missing from Almay in view of Soirinsuo to render the independent claims obvious, these grounds of rejection cannot be maintained.

In view of the above, Applicants respectfully request the rejection of claims 5 and 10 be withdrawn.


CONCLUSION

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 842-8110 X120 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

Dated: 3/26/07



Eamon J. Wall
Registration No. 39,414
Attorney for Applicants

WALL & TONG, LLP
595 Shrewsbury Avenue, Suite 100
Shrewsbury, New Jersey 07702
Telephone: 732-842-8110
Facsimile: 732-842-8388